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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/584,226	06/23/2006	Walter Blum	RO4265US (#90568)	9147
28672 7590 06/11/2009 D. PETER HOCHBERG CO. L.P.A. 1940 EAST 6TH STREET CLEVELAND, OH 44114				
EXAMINER NORDMEYER, PATRICIA L				
ART UNIT		PAPER NUMBER		
1794				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/584,226

**Applicant(s)**

BLUM ET AL.

**Examiner**

Patricia L. Nordmeyer

**Art Unit**

1794

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 4/6/09.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 12 and 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 14-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Repeated Rejections***

1. The 35 U.S.C. 103(a) rejection of claims 1 – 4, 6 – 11 and 14 – 16 over Plamthottam et al. (WO 89/00106) in view of Valdez (USPGPub 2004/0219356 A1) in the office action dated December 3, 2008 is repeated as Applicant's arguments in the response dated April 6, 2009 are found to be unpersuasive. The rejection is repeated below for Applicant's convenience.

Plamthottam et al. discloses a self-adhesive, flexible sealing tape (Abstract) comprising at least one flexible, self-adhesive core/carrier layer (Page 3, lines 11 - 15) provided with an envelope/two-sided coating comprising a second adhesive system (Page 3, lines 17 - 20), wherein the envelope/coating of comprises an expanded pressure-sensitive adhesive tape (Page 3, lines 17 – 20; Page 6, lines 18 - 22), and that the material for the core/the carrier layer is selected from the group comprising thermoplastic rubbers on the basis of styrene-isoprene-styrene block copolymers, styrene-butadiene-styrene block copolymers, copolymers of vinyl acetate and acrylates (Page 10, lines 4 - 35) that is thermally cross-linked (Page 11, lines 31 – 35) as in claim 1. With regard to claim 2, the material for the core/the carrier layer has a glass transition temperature ( $T_g$ ) of below 0 °C (Page 10, lines 11 – 15). As in claim 3, the pressure-sensitive adhesive tape is based on a pure dispersion acrylate (Page 30, lines 10 – 20; Page 37, lines 25 - 29). Regarding claim 4, the pure dispersion acrylate is based on plasticizing monomers selected from the group consisting of 2-ethylhexyl acrylate, 1-butyl acrylate and n-butyl acrylate (Page 30, lines 10 – 20; Page 37, lines 25 - 29). With regard to claim 6, the thickness of the core/the carrier layer is between 0.1 mm and 8 mm (Page 9, lines 10 – 12). As in claims 7 and

15, the width of the core/the carrier layer is between 1 mm and 10 mm (Page 9, lines 10 - 12). Regarding claims 8 and 16, the thickness of the envelope/coating is between 0.2 and 1.5 mm (Page 9, lines 12 - 14). However, Plamthottam et al. fails to disclose the envelope/two-sided coating completely surrounding at least one carrier/core layer, the envelope/coating has a foam-like structure, the sealing tape is equipped with reinforcing elements which stabilize the sealing tape in the longitudinal direction, the reinforcing element is selected from the group consisting of threads, nonwovens or interlaid scrims, wovens, knitted fabrics and crocheted fabrics and the tape is used for adhesively bonding vapour barrier films or vapour retarder films, by adhesively bonding said films to walls.

Valdez teaches disclose an adhesive tape (Abstract) the envelope/coating has a foam-like structure (Page 4, Paragraph 0045), the sealing tape is equipped with reinforcing elements which stabilize the sealing tape in the longitudinal direction (Page 4, Paragraph 0049) and the reinforcing element is selected from the group consisting of threads, nonwovens and wovens (Page 4, Paragraph 0049) for the purpose of forming a tape that can withstand humidity and extreme temperatures without suffering from disintegration (Page 1, Paragraph 0014).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the foam tape with the stabilizing structure in Plamthottam et al. in order to form a tape that can withstand humidity and extreme temperatures without suffering from disintegration as taught by Valdez.

With regard to the limitation “the tape is used for adhesively bonding vapour barrier films or vapour retarder films, by adhesively bonding said films to walls”, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

With regard to the limitation “the envelope/two-sided coating completely surrounding at least one carrier/core layer”, Plamthottam et al. discloses that the layers of the adhesive tape are extruded together to form the tape. It would have been obvious to one of ordinary skill in the art to change the shape of the layers to surround the core since it requires only a change in shape. MPEP 2144.04.

2. The 35 U.S.C. 103(a) rejection of claim 5 over Plamthottam et al. (WO 89/00106) in view of Valdez (USPGPub 2004/0219356 A1) and Peltier (USPN 3,297,846) in the office action dated December 3, 2008 is repeated as Applicant’s arguments in the response dated April 6, 2009 are found to be unpersuasive. The rejection is repeated below for Applicant’s convenience.

Plamthottam et al., as modified with Valdez, disclose the claimed invention except for the pressure-sensitive adhesive tape comprises an adhesive based on a material selected from the group consisting of vinyl isobutyl ether and isobutene.

Peltier teaches a self-adhesive, flexible sealing tape (Figure 2) comprising at least one flexible, self-adhesive core or at least one flexible, self-adhesive carrier layer (Figure 2, #12) provided with an envelope or two-sided coating comprising a second adhesive system (Figure 2, #18 and 14), wherein the envelope/coating of comprises an expanded pressure-sensitive adhesive tape (Column 3, lines 61 – 70), wherein the pressure-sensitive adhesive tape comprises an adhesive based on a material selected from the group consisting of vinyl isobutyl ether and isobutene (Column 3, lines 62 – 65) for the purpose of attaching the tape to a surface (Column 3, lines 64 – 66).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the adhesive in the modified Plamthottam et al. in order to attach the tape to a surface as taught by Peltier.

### ***Response to Arguments***

3. Applicant's arguments filed April 6, 2009 have been fully considered but they are not persuasive.
4. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5

USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, all the references are directed towards adhesive tapes for adhering components together, which leads to motivation for combination.

5. In response to Applicant's argument that Plamthottam et al. do not disclose a sealing tape and the envelope/coating comprising an expanded pressure-sensitive adhesive tape, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In response to applicant's arguments, the recitation sealing tape has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In response to Applicant's argument that Plamthottam et al. do not disclose the envelope/coating comprising an expanded pressure-sensitive adhesive tape, Plamthottam et al. does disclose an envelope/two-sided coating comprising a second adhesive system (Page 3, lines 17 - 20), wherein the envelope/coating of comprises an expanded pressure-sensitive adhesive tape (Page 3, lines 17 - 20; Page 6, lines 18 - 22).

6. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a hot melt adhesive core material which does contain any filler) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to Applicant's argument that Plamthottam et al. fail to disclose the material for the core/the carrier layer has a glass transition temperature (T<sub>g</sub>) of below 0 °C, Plamthottam et al. does disclose the core/carrier material with the desired temperature (Page 10, lines 11 – 15). Plamthottam et al. clearly states that the balance of the adhesive may be comprised of a material with a temperature of 10°C, not that it is comprised of the material.

In response to Applicant's argument that Plamthottam et al. does not disclose a pure dispersion acrylate but a solution acrylate, Plamthottam et al. disclose the pure dispersion acrylate is based on plasticizing monomers selected from the group consisting of 2-ethylhexyl acrylate, 1-butyl acrylate and n-butyl acrylate (Page 30, lines 10 – 20; Page 37, lines 25 – 29), wherein all of the materials are acrylates.

In response to Applicant's argument that Plamthottam et al. does not disclose the desired thickness for the envelope layers, Plamthottam et al. disclose the thickness of a single carrier layer is 0.127 mm (Page 9, lines 12 – 14), therefore, the thickness of an envelope layer would be



twice that, 0.254 mm, which would meet the claim limitation, which also enforces that Plamthottam et al. teaches the expanded adhesive layer.

In response to Applicant's argument that Plamthottam et al. fail to disclose the envelope/two-sided coating completely surrounding at least one carrier/core layer, Plamthottam et al. discloses that the layers of the adhesive tape are extruded together to form the tape. It would have been obvious to one of ordinary skill in the art to change the shape of the layers to surround the core since it requires only a change in shape. MPEP 2144.04.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (571)272-1496. The examiner can normally be reached on Mon.-Fri. from 10:00-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David R. Sample can be reached on (571) 272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Primary Examiner  
Art Unit 1794

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